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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,832	01/12/2004	Hayden Bostock	5163BD-1-1	2377
22442	7590	11/16/2004	EXAMINER	
SHERIDAN ROSS PC 1560 BROADWAY SUITE 1200 DENVER, CO 80202			NGUYEN, SON T	
			ART UNIT	PAPER NUMBER
			3643	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/756,832	Applicant(s) BOSTOCK, HAYDEN	
	Examiner Son T. Nguyen	Art Unit 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/16/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: as shown in figs. 1a,1b,2a,2b,2c.

Species II: as shown in figs. 1c,1d,1e,1f,3a,3b,3c.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there are generic claims.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Robert Traver on 10/15/04 a provisional election was made without traverse to prosecute the invention of species I, claims 1-4,6,8-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5 & 7 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-4,6,8-10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 2, since claim 2 is dependent upon claim 1, claiming the mounting member, the foot support member, and the one or more mountings, again in claim 2, is unclear because the members have already been claim in claim 1. In addition, for the embodiment of fig. 2a, which

Art Unit: 3643

applicant has elected, the claim language cannot read on one mounting only because it would be impossible to hold the foot member to that of the mounting member because only one side of the foot member has the projection or mounting, which is not true of embodiment of fig. 2a, especially when the claim language states "fully disconnected". The examiner suggests that the applicant claims, for the sake of embodiment of fig. 2a, that there are two mountings/projections on each side of the foot support member that fit into recesses in the mounting member to avoid confusion and unclear claim language.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-4,6,8** are rejected under 35 U.S.C. 102(b) as being anticipated by US 1321653 (herein 653).

For claims 1 & 2, 653 teaches a safety stirrup including a generally U-shaped mounting member 8, and a foot support member 14, such that when the rider's foot is in the normal use position, the foot support member is restrained by one or more mountings or projections 16,15, wherein, during normal use, the projections are located in one or more recesses 12,13 adjacent the ends of the U-shaped mounting member but vertically upward movement of the rider's foot out of the normal use position causes the one or more mountings to release the foot support member sufficiently that the foot

Art Unit: 3643

support member can move in the same direction as the rider's foot until the foot support member is fully disconnected from the U-shaped mounting member, the one or more projections moving in their respective recess(es) and rotating in the same direction as the rider's foot prior to the foot support member being fully disconnected from the U-shaped mounting member (lines 75-85).

For claim 3, 653 teaches wherein one or more of the mountings comprises one or more additional projections 15 which, when the stirrup is in the normal use position, is received in a complementary shaped recess 13.

For claim 4, 653 teaches wherein the one or more projections 15,16 are located on the foot support 14 and are received in one or more recesses 10,13 in the U-shaped mounting member.

For claim 6, 653 teaches wherein one additional projection 15 is located on one side of the foot support member, and another additional projection 15 is located on an opposing side of the foot support member, each additional projection being received in a complementary shaped recess 13 in the U-shaped mounting member. Note, ref. 16 is considered the one projection or mounting as claimed in claims 1 & 2.

For claim 8, 653 teaches wherein at least one of the complementary shaped recesses includes an indentation 12 in which the additional projection 15 resides during normal use (see fig. 3).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3643

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over 653 (as above) in view of US 1052327(herein 327). 327 teaches a safety stirrup in which 327 employs a biasing means 25 to resist movement of the projections 26 in their respective recesses 18,34. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a biasing means as taught by 327 in the safety stirrup of 653 in order to resist movement of the projections before breaking lose for emergency.

9. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over 653 (as above). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the safety stirrup of 653 out of a non-metallic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious choice.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 3643

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).


11. **Claims 1-4,6,8-10** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6698169. Although the conflicting claims are not identical, they are not patentably distinct from each other because both US6698169 and the present invention claim a safety stirrup including a generally U-shaped mounting member, and a foot support member, such that when the rider's foot is in the normal use position, the foot support member is restrained by one or more mountings or projections, wherein, during normal use, the projections are located in one or more recesses adjacent the ends of the U-shaped mounting member but vertically upward movement of the rider's foot out of the normal use position causes the one or more mountings to release the foot support member sufficiently that the foot support member can move in the same direction as the rider's foot until the foot support member is fully disconnected from the U-shaped mounting member, the one or more projections moving in their respective recess(es) and rotating in the same direction as the rider's foot prior to the foot support member being fully disconnected from the U-shaped mounting member. In addition, both also claim the projections being received in complementary shaped recesses in the mounting member, a biasing means and a non-metallic material.

Art Unit: 3643

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 703-305-0765. The examiner can normally be reached on Mon-Fri from 9:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 703-308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Son T. Nguyen
Primary Examiner
Art Unit 3643

stn